



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,863	08/31/2001	Carl H. Staelin	10019510-1	2228

7590 10/19/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

NGUYEN, NHON D

ART UNIT	PAPER NUMBER
----------	--------------

2179

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/943,863	Applicant(s) STAEIN ET AL.	
	Examiner Nhon.(Gary) D. Nguyen	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,7-9,12,14 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7-9, 12, 14, and 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to amendment, filed 07/28/2005.
2. Claims 1, 4, 7-9, 12, 14, and 18-24 are pending in this application. In this amendment, no claim is canceled, no claim is amended, and no claim is added. This action is made final.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4, 7-9, 12, 14 and 18-24 rejected under 35 U.S.C. 102(e) as being anticipated by Morcos et al. ("Morcos", US 6,384,849).

As per claim 1, Morcos teaches a computer implemented method and corresponding system for providing a menu in relation to a document comprising the steps/means:

creating a document within a program; (creating a word document, with a embedded behavior spreadsheet object, within the MS Word program; col. 13, lines 25-34);

creating a predetermined behavior that can be used to modify documents opened within the program but that is not generally available for selection from a main menu of the program (e.g. Excel server program 1105 of fig. 11 defines a predetermined behavior, for Excel documents, that is not available from the main Word menu 1100);

specifically associating the predetermined behavior with the created document (the merged menu items in Morce's system are clearly the predetermined behaviors associated with a spreadsheet object of the created word document; col. 13, lines 27-34; e.g. any Excel document is associated with the predetermined behavior 1105 of fig. 11); and

creating a menu item associated with the predetermined behavior that is configured for addition to the main menu when the defined document is opened within the program but that is not made generally available for all documents opened within the program, such that the predetermined behavior will be available for selection from the main menu for the defined document but not necessarily for other documents opened within the program (col. 13, lines 25-34 and 1110 of fig. 11; col. 15, lines 25-57).

As per claim 4, which is dependent on claim 1, Morcos teaches the method further comprising merging the menu item associated with the predetermined behavior with the main menu of the program when the created document is opened within the program such that the menu item associated with the predetermined behavior is presented to the user for selection in specific association with the created document (col. 13, lines 25-34 and 1110 of fig. 11; col. 15, lines 23-57).

As per claim 7, which is dependent on claim 1, Morcos teaches specifically associating the predetermine behavior with the created document comprises creating a list of behaviors associated with the created document (fig. 8; col. 12, line 60 – col. 13, line 22).

As per claim 8, which is dependent on claim 7, Morcos further teaches defining a pointer associated with the created document, the pointer pointing to the list of behaviors (col. 9, lines 9-25).

As per independent claim 9, it is a similar scope to claim 1; therefore, it should be rejected under the same rationale.

As per independent claim 12, Morcos teaches a computer implemented method and corresponding system for providing a menu in relation to a particular document that was created and is running in a program comprising the steps/means:

receiving a user input (col. 9, lines 53-55);

generating a command message in response to the user input, the command message comprising a command ID indicative of a predetermined process that corresponds to a selected menu item (col. 9, lines 9-35 and lines 47-67);

determining if the command ID corresponds to a predetermined behavior that has been specifically associated with the particular document; and initiating a process represented by the predetermined behavior where it is determined that the command ID corresponds to the predetermined behavior that has been specifically associated with the particular document (col. 9, lines 9-35 and lines 47-67).

As per claim 14, which is dependent on claim 12, Morcos teaches the user input comprises selection of a displayed menu item (col. 9, lines 53-55).

As per claim 18, which is dependent on claim 4, Morcos teaches merging the menu item comprises adding a new menu to the main menu, the merged menu item being contained within the new menu (col. 13, lines 25-34 and 1110 of fig. 11; col. 15, lines 23-37).

As per claim 19, which is dependent on claim 4, Morcos teaches merging the menu item comprises adding the menu item to an existing menu of the main menu (col. 13, lines 25-34 and 1110 of fig. 11; col. 15, lines 23-37).

As per claim 20, which is dependent on claim 7, Morcos teaches creating a list of behaviors comprises creating a list of behaviors that includes the predetermined behavior (fig. 8; col. 12, line 60 – col. 13, line 22).

As per claim 21, which is dependent on claim 9, Morcos teaches the login configured to create a main menu is configured to create a main menu comprising menu items that are associated with behaviors that are generally available for all document opened within the program (Word container program 1100 of fig. 11 is a main menu including menu items that are associated with behaviors that are generally available for all Word documents opened within the program).

As per claim 22, which is dependent on claim 9, it is rejected under the same rationale as claim 7.

As per claim 23, which is dependent on claim 22, it is rejected under the same rationale as claim 8.

As per independent claim 24, it is a similar scope to claim 12; therefore, it should be rejected under the same rationale.

Response to Arguments

5. Applicant's arguments filed 07/28/2005 have been fully considered but they are not persuasive.

Applicant argued that Morcos does not disclose merging menu items into a main menu of a first program when a file that was created within that same program is opened and furthermore, Morcos says nothing about “specifically associating the predetermined behavior with the created document.

The Examiner disagrees for the following reasons. Morcos, at column 13, lines 29-31, teaches “the embedded spreadsheet object may be activated and edited from the word processing window”. This reciting clearly shows that only one program, which is word processing program, is used for opening a document and for editing the embedded spreadsheet object, when that embedded spreadsheet object is activated within the same word processing program. Moreover, the shared commands from the embedded spreadsheet object in Morce’s system are clearly the

predetermined behaviors associated with a spreadsheet object of the created word document (column 13, lines 27-34).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Inquiries

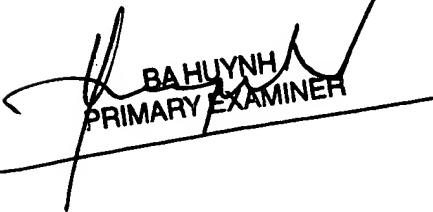
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon (Gary) D. Nguyen whose telephone number is (571)272-4139. The examiner can normally be reached on Monday - Friday with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571)272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2179

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nhon (Gary) Nguyen
October 16, 2005


BA HUYNH
PRIMARY EXAMINER